

REMARKS

Applicants have studied the Office Action dated July 7, 2005 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-3, 4, 6, 8, 14, and 17-23 are pending. Claims 1 and 14 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

Allowable Subject Matter

The Applicants wish to thank Examiner Landau for indicating the allowable subject matter of claim 14 and the allowance of claims 17-23.

Claim Objections

The Examiner objected to claim 14 because of specified informalities. The Applicants have amended claim 14 to correct the typographical error identified by the Examiner. No new matter has been added by this amendment. The Applicants believe that the Examiner's objection has been overcome by this amendment.

Rejection under 35 U.S.C. § 112

The Examiner rejected claims 1-3 under 35 U.S.C. § 112, first paragraph, for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicants have cancelled claims 1-3, without prejudice, thereby rendering the rejection under 35 U.S.C. §112 moot.

(Page 4, para 2) Rejection Under 35 U.S.C. § 102(e)

As noted above, the Examiner rejected claims 1-4, 6 and 8 under 35 U.S.C. § 102(e) as being anticipated by Glownia et al (U.S. Patent No. 6,485,599). The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated

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by Glownia.¹

The Applicants have cancelled claims 1-3, without prejudice, thereby rendering the rejection of those claims moot.

The Applicants have submitted, in accordance with MPEP §715.01(a), an unequivocal declaration under 37 C.F.R. §1.132, that has been executed by all of the inventors of the present application, that two of the co-inventors of the subject patent application, i.e., Robert J. von Gutfeld and James H. Glownia, also invented the subject matter disclosed in the cited Glownia reference - U.S. Patent Number 6,485,599. The Applicants respectfully assert that the facts declared in the attached declaration under 37 C.F.R. §1.132 disqualifies the Glownia reference from being used against the present invention, and that the rejection under 35 U.S.C. §102(e) should be withdrawn.

Further, the Applicants further point out that the Glownia reference would not be properly applied under 35 U.S.C. §103. The Applicants have attached an affidavit under 37 C.F.R. §1.132 stating that the subject matter of the Glownia reference was conceived of and invented by two of the three inventors of the present invention. Further, the Applicants note that the subject matter of the Glownia reference and of the subject matter of the subject patent application were, at the time the invention was made, subject to an obligation of assignment to the same assignee, International Business Machines, as duly recorded on reel/frame 012045/0487. This common obligation of assignment disqualifies the Glownia reference, under MPEP §706.02(l)(2), from being used against the present invention.

(Page 6, para 1) Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Inou, U.S. Patent No. 5,793,461 (hereinafter "*Inou*"). The Applicants have cancelled claims 1-3, without prejudice, thereby rendering the rejection under 35 U.S.C. §103(a) moot.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

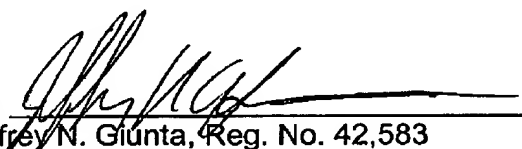
Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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